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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,656	07/15/2003	Klaus Hilbig	CM2504RQ	7175

27752 7590 12/02/2005

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,656

Applicant(s)

HILBIG ET AL.

Examiner

José A. Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/4/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., US Patent No. 5,990,377 in view of applicants admission further evidenced by Müller, GB

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2376436 A, or Roussel et al., WO 99/45205 or Hein et al., US Patent No. 6,863,107 B2 or

Kamps et al., US Patent No. 5,702,571.

Regarding claims 1-8, Chen et al. teach a tissue paper having a three-dimensional topography comprising elevated regions onto which hydrophobic matter is deposited or printed and a plurality of spaced apart depressions see abstract. Chen et al. teach the hydrophobic material can be oils, waxes, emulsions, synthetic fibers, etc. and teach the same disclosed substances, (disclosed on paragraph bridging pages 8 and 9 of the current application), such as quaternary ammonium, mineral oil, waxes, silicones, etc, see for example column 35, lines 25-43 and abstract; column 37, line 53 through column 40, line 9. The embossing of the web is disclosed in, column 29, lines, 22-30 and column 36, lines 30-40. Chen et al. do not teach the specifics of the embossing members, i.e., the embossing elements per cm^2 . However, on pages 6-8, applicants admit that using such embossing process is well known in the art and known as stretch-embossing, also known as micro-embossing, and therefore, using micro-embossing or stretch-embossing as the embossing suggested by Chen et al., would have been obvious to one of ordinary skill in the art, since this is conventional in the art. One of ordinary skill in the art would have reasonable expectation of success if the embossed tissues of the cited reference were embossed with an embossing system having the density embossing element as claimed, i.e., at least 30 embossing elements/ cm^2 . Moreover, Müller, Roussel et al., Hein et al., Kamps et al., to mention a few, teach micro-embossing systems in which a tissue is embossed with an embossing device having at least 30 embossing elements / cm^2 , see abstracts. They teach that the advantages of using such mechanism, device, are: produces

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a softer tissue, improved feel and good mechanical strength, see pages 1-2 of Müller; abstract of Roussel et al.; Kamps et al., abstract. Therefore, using a device as taught by Müller or Roussel et al or Hein et al. would have been obvious to one of ordinary skill in the art in order to obtain the advantages discussed above. Note that Chen et al. teach that the hydrophobic material is deposited on the top/raised portion of the web. Note also that the cited references and the admitted prior art teach the specifics of the micro-embossing elements as claimed. The embossing area is taught by the Chen et al. and the secondary references. Moreover, it has been held that "[T]he discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *In re Aller*, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1995).

As to claims 7-8, these are product by process claims and the combination of references teach a tissue that Must have all the limitation of the claimed product, since the process steps are the same and are made using the same type of raw materials. As the afore mentioned claims are product by process claims, it is deemed that "[A]ny difference imparted by the product by process claims would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicants to establish that their product is patentably distinct, ..." *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

Further, "[P]rocess limitations are significant only to the extent that they distinguish the claimed product over the prior art product." In re Luck, 177 U.S.P.Q. 523 (1973).

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luu et al., US Patent No. 6,352,700 in view of Kamps et al., cited above.

Luu et al. teach a tissue, which is lotioned to increase the softness of the tissue, increase soothing, lubricious feel, abstract. They teach that the tissue has the effect of keeping the skin mantle while making the product feel smooth, lubricious and non-greasy, see abstract. They teach also that the tissue could be embossed, column 3, lines 32-38.

Kamps et al. teach a tissue which is embossed with embossed rolls, which could be steel or rubber rolls or a combination of steel and rubber rolls, column 3, lines 29-38, said rolls having at least 15 discrete, male elements per square centimeter, preferably from about 30 to 95 embossing elements/cm², column 3, lines 49-65 and that embossing in such a way produces a tissue having adequate softness, bulk and strength and having an unique balance of properties, see abstract. Therefore, embossing the tissues taught by Luu et al. using the embossing rolls taught by Kamps et al. would have been obvious to one of ordinary skill in the art in order to obtain the advantages discussed above.

Conclusion

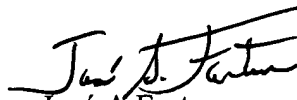
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Lotioned Tissues."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


José A Fortuna
Primary Examiner
Art Unit 1731

JAF